



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/828,514	04/19/2004	Christopher Szeto	017887-013000US	4298
20872	7590	10/05/2006	EXAMINER	
MORRISON & FOERSTER LLP 425 MARKET STREET SAN FRANCISCO, CA 94105-2482			CABUCOS, MARIE G	
			ART UNIT	PAPER NUMBER
			2163	

DATE MAILED: 10/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/828,514

Applicant(s)

SZETO ET AL.

Examiner

Marie Antoinette Cabucos

Art Unit

2163

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 3/2/2005 and 3/27/2006.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Yaron Mayer (US Publication no. 2004/0122810).

Regarding claims 1 and 11, Mayer discloses in figures 1, 4 and 8 a method and computer system for performing an Internet search launched from an instant messaging application, comprising providing a first IM user with an option to launch an Internet search of a second IM user directly from the IM application (43); transmitting a search query identifying the second IM user to a search server (44); searching the Internet for web pages matching the search query to generate search results using the search server; accessing a user profile of the second IM user from an IM member profile database; sorting the search results in order of relevance to information in the user profile of the second IM user; and displaying the sorted search results to the first IM user (figure 8).

3. Regarding claims 2-4 and 12-14, Mayer discloses in figures 1, 4 and 8 a method and computer system for performing an Internet search launched from an instant messaging application according to claim 1, further comprising providing the first IM user with an option to launch an Internet search from the IM application based on a topic; and transmitting a second search query identifying the topic to the search server (paragraph 0006); further comprising searching the Internet for web pages matching the second search query to generate second search results using the search server; and displaying the second search results to the first IM user (figure 1); and wherein displaying the search results further comprises displaying the user profile along with the search results (figure 8).

4. Regarding claims 5-7 and 15-17, Mayer discloses in figures 1, 4 and 8 a method and computer system for performing an Internet search launched from an instant messaging application according to claim 2, wherein providing the first IM user with the option to launch the Internet search from the IM application based on the search query further comprises automatically displaying a string that identifies the second IM user in a dialog box (paragraph 0016); wherein the string is a name that is accessed from an electronic address book; and wherein the string is a identification number that identifies the user profile (paragraph 0017).

5. Regarding claims 8-10 and 18-20, Mayer discloses in figures 1, 4 and 8 a method and computer system for performing an Internet search launched from an instant messaging application according to claim 1, wherein transmitting the search query to the search server further comprises transmitting a URL that contains an ID

Art Unit: 2163

identifying the second IM user to the search server (paragraph 0068); wherein providing the first IM user with the option to launch the Internet search from the IM application further comprises providing a search option on a tool bar or drop down list on a screen displayed by the IM application (paragraph 0069); and wherein the sorted search results are displayed in a web browser window generated by a web browser application (paragraph 0093).

Pertinent Prior Art

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Prior art of record Dane et al (US Patent no. 6,785,679) discloses a method and apparatus for sending and tracking resume data sent via URL.

Prior art of record Julia Tema (US Publication no. 2002/0091936) discloses a method of monitoring multi-media communication between parties.

Prior art of record James A. Roskind (US Publication no. 2003/0065721) discloses a passive personalization of buddy lists.

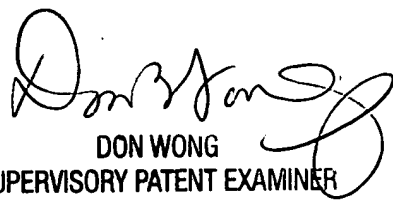
Prior art of record Blattner et al (US Publication no. 2004/0179039) discloses using avatars to communicate.

Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marie Antoinette Cabucos whose telephone number is 571-272-8582. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don K. Wong can be reached on (571) 272-1834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


DON WONG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

Marie Antoinette Cabucos
Examiner
Art Unit 2163